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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,503	07/23/2003	Malcolm MacQuoid	2203.PACI.NP	1968

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EXAMINER	
GAY, JENNIFER HAWKINS	

ART UNIT	PAPER NUMBER
3672	

DATE MAILED: 05/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/626,503	MACQUOID ET AL.	
	Examiner	Art Unit	
	Jennifer H Gay	3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 March 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10,12-17,19-21 and 24-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10,12-17,19-21 and 24-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 July 2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "**Replacement Sheet**" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claims 20 and 21 are objected to because of the following informalities: Claims 20 and 21 are objected to because the "coconut coir" cannot contain a percentage of the "mixture" as the coir is the part of the mixture as claimed. Based on applicant's argument, it is suggested that claims 20 and 21 be amended to recite --the mixture comprises between 0.5 percent and 28 percent of the coconut coir by weight-- and --the mixture comprises between 1.4 and 14 percent of the coconut coir by weight-- respectively. Appropriate correction is required.

3. Claims 25-27 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 25-27 are considered to not further limit claim 24 because nothing, which materially changes the material of claim 24, has been recited. The configuration of the pellets does not change the composition of the material itself. Rather, the configuration of the pellets recited in claims 25-27 are considered to be merely uses of the pellets and thus do not further limit the material of drilling fluid with coconut coir.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 17 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Burts, Jr. (US 6,016,879).

Regarding claim 17: Burts discloses a method for controlling loss of drilling fluid or lubricating a drilling implement in a borehole that involves mixing coconut coir with the drilling fluid (7:15-33).

Regarding claim 19: The drilling fluid may also include a fibrous material such as cotton, cottonseeds, rice hulls, wood fibers, sawdust, or paper pulp, and/or a flaky material such as wood chips or plastic, and/or a granular material such as nutshells, and/or a slurry such as hydraulic cement, oil-bentonite-mud mixes or other high filter loss drilling fluids.

Regarding claims 20, 21: The coconut coir is between 1 and 28 percent of the drilling fluid by volume.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-10, 12-16, and 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burts, Jr. in view of Silva (US 6,391,120).

Regarding claims 1, 24: Burts discloses a method for controlling loss of drilling fluid or lubricating a drilling implement in a borehole that involves mixing coconut coir with the drilling fluid (7:15-33). Burts discloses that the any size material may be used and that the material may be ground to a fine particle size prior to being placed in the borehole (7:45-60).

Burts discloses all of the limitations of the above claims except for the coconut coir being pelletized.

Silva discloses pelletized coconut coir (2:48-58). Silva further teaches that the coir will swell when exposed to fluid (2:33-39).

It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have used coconut coir pellets as taught by Silva in the method and fluid of Burts in order to have used a material that easy to obtain and had a high oil absorption rate thus preventing fluid loss in a wellbore while drilling.

Regarding claims 2-10: The drilling fluid may also include a fibrous material such as cotton, cottonseeds, rice hulls, wood fibers, sawdust, or paper pulp, and/or a flaky material such as wood chips or plastic, and/or a granular material such as nutshells, and/or a slurry such as hydraulic cement, oil-bentonite-mud mixes or other high filter loss drilling fluids.

Regarding claim 12: Though not specifically disclosed in Burks or Silva, the pellets of coir would inevitably break into smaller particles once introduced to the drilling fluid as the turbulence of mixing with the fluid and being forced through the borehole would cause the pellets to break apart.

Regarding claim 13: Though not specifically disclosed in Burks or Silva, the coir would not swell until it was placed in contact with a fluid, as this would defeat the purpose of the coir otherwise.

Regarding claims 14, 15: The coconut coir is between 1 and 28 percent of the drilling fluid by volume.

Regarding claim 16: The borehole is an oil or gas well.

Regarding claims 25-27: As claims 25-27 do not further limit the claim from which they depend, claim 24, as laid out above in paragraph 3, the claims are rejected with claim 24 above.

Regarding claim 28: While not disclosed by either reference, coconut coir naturally contains short fibers, flakes, granular pieces, and power of coconut husk.

Response to Arguments

8. Thought the changes made to Figure 1 presented in the amendment of 7 March 2005 are considered sufficient to overcome the objection given in the previous Office Action, the figure has not been presented as a "Replacement Sheet" as specifically called for above.

9. The objection to the specification and claims 12 and 26 has been withdrawn in view of applicants' amendment.

10. Applicant has indicated that MacQuoid et al. (US 2004/0025422) is commonly owned with the instant application thus does not qualify as prior art under 35 USC 103. Therefore, MacQuoid et al. has been withdrawn as an applied reference and the rejection of the claims changed accordingly.

11. Applicant's arguments filed 7 March 2005 have been fully considered but they are not persuasive.

Applicant has argued that the prior art does not teach using pelletized coconut coir. While the examiner agrees that the prior art of record prior to this Office Action did not teach pelletized coconut coir, the newly applied reference of Silva teaches the use of pelletized coir for the purpose of oil clean up. It is further noted that in paragraph [0017] of the instant application, applicant has acknowledged that coconut coir is useful for oil spill clean up. The examiner has interpreted this to indicate that coconut coir used for oil spill clean up could also be used as a drilling fluid for controlling fluid loss.

Applicant has indicated that the amendment to claim 17 to require the mixture "consist essentially" of coconut coir and drilling fluid changes the claim to recite a drilling fluid with the use of coconut coir exclusively as a lost circulation additive.

Contrary to applicants' assertions, the phrase "consisting essentially of" is not automatically considered an exclusory phrase. This transitional phrase "limits the scope of a claim to the specified materials or steps and 'those that do not materially affect the basic and novel characteristic(s)' of the claimed invention. Further, "absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, 'consisting essentially of' will be construed as equivalent to 'comprising.'"

See MPEP 2111.03 [R-2]. While applicant has indicated in the specification that the drilling fluid can contain only coconut coir, it has not provided any evidence that the addition of any other component would materially affect the basic and novel characteristics of the fluid. Applicant has the burden of showing that the introduction of additional components would materially change the characteristics of applicant's invention.

The examiner would like to further note that if the transitional phrase of claim 17 was read as a "closed" phrase, claim 19 would be rejected under 35 USC 112, first paragraph as having a scope that is not commiserate with the claim from which it depends and not enabled in the specification. A mixture that contains **only** drilling fluid and coconut coir cannot contain any other components.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer H Gay whose telephone number is (571) 272-7029. The examiner can normally be reached on Monday-Thursday, 6:30-4:00 and Friday, 6:30-1:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer H Gay
Patent Examiner
Art Unit 3672

JHG
May 5, 2005